

caption, as was done in the originally filed application. However, in the interest of facilitating prosecution of the current application, Applicant's representative has amended the "Brief Description of the Drawings" section as indicated by the Examiner. The Examiner additionally rejected claim 7 under 35 U.S.C. § 112, second paragraph as being indefinite due to a typographical error and due to what the Examiner considers to be an improper Markush grouping format. Applicant's representative has amended claim 7, above, to correct the deficiencies pointed out by the Examiner.

In the Office Action of October 11, 2000, the Examiner has rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Cowan, U.S. Patent No. 3,734,396 ("Cowan") in view of Welt, U.S. Patent No. 5,141,485 ("Welt"). The Examiner additionally rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Cowan and Welt in view of Holcomb, et al., U.S. Patent No. 5,933,085 ("Holcomb"). Applicant's representative respectfully traverses the 35 U.S.C. § 103(a) rejections of claims 1-7.

Applicant's invention is, in Applicant's representative's opinion, clearly described and clearly illustrated in the current application. One embodiment of Applicant's invention is a single-sheet combined registration form and key packet that may be printed during registration of a hotel guest. The combined registration form and key packet may be printed on a laser printer by a hotel clerk after entering hotel guest information into a computerized registration system. The hotel clerk may then detach the registration form from the combined registration form and key packet. The registration form is signed by the hotel guest and returned to the hotel clerk, while the hotel clerk folds the key packet along perforated lines and inserts a hotel room key into the completed key packet. Finally, the hotel clerk provides the folded key packet including the hotel room key to the hotel guest.

Figure 2 illustrates a single-sheet, combined registration form and key packet blank. The blank includes a vertical line of perforations (202 in Figure 2) and two horizontal lines of perforations (204 and 210 in Figure 2). In addition, the blank includes, as illustrated in Figure 2, two die-cut slots (214 and 212 in Figure 2) for holding a metal key and a rectangular magnetic key card, respectively. Independent claim 1 is directed to the single-sheet, combined registration form and key packet illustrated in Figure 2.

By contrast, Cowan discloses an airline ticket envelope, shown in Figure 1 of Cowan, constructed from a die-cut blank (12 in Figure 2). In section 11 of the Office Action, the Examiner characterizes Cowan as follows:

Cowan discloses an envelope comprising a registration form (22); an unfolded packet (12) separated from the registration form by a line of perforations (54); the unfolded packet including a number of liens of perforations (34, 44); a vertical line of perforations (44) bisecting the packet; a lower tab (20) being separated from a central portion of the unfolded packet by a second horizontal line of perforations (40); the form and packet having pre-printed indicia (col. 2, lines 62-67 through col. 3, lines 3). Printing the indicia on a printing device is inherently known. Cowan discloses the claimed invention except for one or more die-cut slots in the unfolded packet.

In Applicant's representative's opinion, the Examiner has mischaracterized Cowan. First, the Examiner characterizes a flap (22 in Figure 2) extending vertically above a line of perforations (54 in Figure 2) as a registration form, when, in fact, this flap "constitutes a boarding pass having pertinent indicia printed on its face" (Cowan, column 2, lines 64-65). Next, the Examiner characterizes two vertical fold lines (34 and 44 in Figure 2) as lines of perforations, further characterizes fold line 44 as a vertical line of perforations, and additionally characterizes fold line 40 in Figure 2 as a horizontal line of perforations. In Cowan, a line of perforations is specifically described as a "perforated line," while, by contrast, a non-perforated fold line is described as a "fold line." Cowan's ticket envelope includes a single line of perforations (54 in Figure 2) described as a "perforated line 54 in overlying relation to panel 1" (Cowan, column 3, lines 19-20). Cowan's ticket envelope includes 3 fold lines. A first fold line is specifically designated "fold line 34" in numerous places in the paragraphs starting on line 21 of column 2, a second fold line is repeatedly designated as "fold line 40" in numerous places in the paragraph beginning on line 37 of column 2, and a third fold line is repeatedly designated as "fold line 44" in the paragraph beginning on line 55 of column 2, and in subsequent paragraphs. Moreover, in Figure 2, the single perforated line 54 is shown as a bolded dashed line, while the three fold lines are shown as more or less continuous lines. Thus, Cowan discloses only one line of perforations, rather than the four identified by the Examiner.

Welt describes a pocket folder and a method for making a pocket folder. Unlike prior-art single-sheet, die-cut, cardboard pocket folders, Welt's pocket folder is made from two separate cardboard pieces, a first rectangular piece, referred to as a "folder panel," shown in Figure 2 of Welt and a second die-cut piece shown in Figure 3 of Welt. The second, die-cut piece shown in Figure 3 is termed a "pocket panel" and is "adhesively attached to the folder panel to provide an opening to the pocket which extends along both the upper edge and side edge thereof" (abstract, lines 13-15). The pocket panel may include "suitable slits 32 for insertion of a business card" (Welt, column 4, lines 13-14).

Holcomb discloses an environmental control lock system that includes an electronic door lock and a guest key card that stores information indicating when the guest intends to check out, so that the electronic door lock can initiate energy-saving climate control actions following the departure of the hotel guest. Holcomb neither teaches, mentions, nor suggests any kind of key packet or envelope for containing a guest key card.

Independent claim 1 of the current application claims a single-sheet registration form and key packet comprising (1) a registration form; (2) an unfolded key packet separated from the registration form by a line of perforations, and unfolded key packet including a number of lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet; and (3) one or more die-cut slots in the unfolded key packet which serve as a slot or slots for a number of keys in the complete key packet. As pointed out above, Cowan discloses a ticket envelope and boarding pass and Welt discloses a cardboard pocket folder. Neither Cowan nor Welt teaches, mentions, or suggests a registration form. The unfolded key packet of the current application includes, in addition to the line of perforations that separate the unfolded key packet from the registration form prior to detachment of the registration form from the unfolded key packet, a number of lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet. Cowan's ticket envelope blank, as noted above, includes a single line of perforations that separate the boarding pass from the remainder of the ticket envelope. Thus, Cowan lacks the "number of lines of perforations" included in Applicant's unfolded key packet. Welt discloses no lines of perforations in either the folded panel or the pocket panel pieces that are combined to form a pocket folder. Moreover, neither Cowan nor Welt teach, mention, or disclose a key packet. Applicant's key packet includes "one or more die-

cut slots . . . which serve as a slot or slots for a number of keys in the complete key packet.” Cowan’s ticket envelope includes no die-cut slots, and Welt’s pocket panel includes four die-cut slots angled in order to receive the four corners of a business card. Welt does not teach, mention, or suggest die-cut slots designed for insertion of either card keys or metal keys. Thus, neither Cowan nor Welt, alone or in combination, teach, mention, or suggest any of the three elements of claim 1. Moreover, Welt explicitly teaches away from a single-sheet combined folder panel and pocket panel of prior-art pocket folders, and instead discloses a two-piece pocket folder. Because neither Cowan nor Welt, alone or in combination, teach, mention, or suggest even one of the three elements of claim 1, Applicant’s representative can see no basis for the Examiner’s 35 U.S.C. § 103(a) obviousness-type rejection of claims 1-6. Because claim 7 depends from independent claim 1, and because Holcomb neither teaches, mentions, nor suggests anything related to key packets, let along single-sheet registration form and key packet blanks, Applicant’s representative can see no basis for the Examiner’s 35 U.S.C. § 103(a) obviousness-type rejection of claim 7.

According to MPEP § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Obviously, the Examiner has failed to establish a *prima facie* case of obviousness. There is no suggestion or motivation in the cited references for any application or implementation related to registration forms and key packets. Second, as noted above, the cited references not only fail to teach or suggest all the claim limitations, but, in fact, fail to teach or suggest even one of the three elements of claim 1.

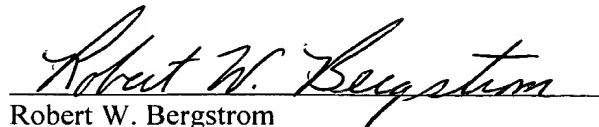
In MPEP § 2141, a standard of patentability that arose in the Supreme Court case *Graham v. John Deere*, 283 U.S. 1, 148 USPQ 459 (1966) is provided in detail. This *Graham* standard includes secondary considerations such as commercial success, long felt but unsolved needs, failures of others, etc. While the current application is directed toward a

relatively simple and straightforward invention, there are a number of such secondary considerations that would argue strongly against an obviousness-type rejection. First, the Applicant has, in the year following filing of the application, built a significant business manufacturing and selling the single-sheet registration form and key packet that is the subject of the current application. The Applicant is selling the single-sheet registration form and key packets to major hotel chains, including Hilton Hotels, which have recognized efficiencies and economies in using Applicant's invention during registration of hotel guests. No such single-sheet registration form and key packet was available prior to Applicant's entry into this field, and Applicant's clients have responded to Applicant's product enthusiastically. Second, Applicant has received notice from several print shops that the print shops have been contacted by third parties to produce single-sheet registration form and key packets as disclosed in the current application, but without the patent pending status included by Applicant on his products. While perhaps a simple invention, Applicant's invention is nevertheless important to Applicant, is extremely well regarded in the hotel industry, and is already a target for copying by Applicant's competitors.

Although Applicant's representative believes that the Examiner's 35 U.S.C. § 103(a) rejections have been traversed in the above response, Applicant's representative also wishes to point out that, even were the Examiner to find references that disclose single-sheet combination forms with all of Applicant's claim limitations but directed towards another type of product or usage, Applicant would nevertheless have a sounds basis for claiming a new usage of the single-sheet combination form. Because the Examiner has yet to find such references, Applicant's representative will defer an extensive new-use argument to a later response in the case that such references are found.

All of the claims remaining in the application are now clearly allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
Summit Law Group, PLLC


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Enclosures:

- Postcard
- Form PTO-1083 (+ copy)
- Petition for an Extension of Time (+ 2 copies)
- Revocation and Substitute Power of Attorney

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